

### **REMARKS**

The Office Action of April 13, 2007, has been considered by the Applicants. No claims are amended or cancelled. Claims 1, 8-15, 17-30, 33-34, and 36-39 remain pending. Reconsideration of the Application is requested.

Claims 1, 8-15, 17-30, 33-34, and 36-39 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by, or in the alternative under 35 U.S.C. 103(a) as allegedly being obvious over Spiewak (U.S. Patent No. 5,336,577). Applicants traverse the rejection(s).

Applicants first wish to note that claim 1 requires four elements: a photogenerating component, a binder, a hole transport component, and an electron transport component. Claim 1 then recites specific weight ratio ranges between these elements.

Spiewak does not anticipate. Spiewak discloses an imaging member having a single layer comprising a pigment (i.e. photogenerating component), a hole transport polymer (poly(ether carbonate), or "PEC"), and fluorenylidene malonitrile derivative (BCFM) (i.e. electron transport component). Applicants note that it is unclear whether the Examiner is interpreting the hole transport polymer to be the binder, the hole transport component, or both with regards to the instant claims. Applicants would appreciate the Examiner's statement in the next Office Action as to how the hole transport polymer is being interpreted.

Assuming the Examiner is interpreting the hole transport polymer as both the binder and the hole transport component, claim 1 requires the ratio of binder to charge transport (i.e. hole transport plus electron transport) to be from about 45:25 to about 55:35. In Spiewak, however, the ratio will always be less than 1:1 because [hole transport polymer < (hole transport polymer + malonitrile)]. Thus, the weight ratio limitation will not be met.

If the hole transport polymer is interpreted as only the binder or only the hole transport component, then the claim limitation requiring the hole transport component or the binder to be present will not met. This requirement is inherent in the weight ratio

limitation. In this respect, Applicants also note that Spiewak discusses the use of polymeric binder with hole transport molecules, but does not discuss their weight ratios.

None of the Examples fall within the claimed ranges. As to Examples I and II, devices 1-1, 2-2, 2-3, and 2-4 explicitly fall outside the ranges of claim 1 because their ratios of photogenerating component to electron transport component are outside the claimed ratios. Devices 1-2 and 2-1 fall outside the ranges of claim 1 because their ratios of photogenerating pigment to binder are outside the claimed ratios. The ratios of Examples III and IV are impossible to determine because no amount of photogenerating component is given. In addition, Example IV, which discloses a PEC:BCFM weight ratio of 1:1 falls outside the ranges of claim 1 because falls outside the claimed ratios of binder to electron transport component.

In discussing obviousness, the Examiner referred to the table at the bottom of column 5. This table discloses a molar ratio of PEC:BCFM of 0.1-10.0 and a weight ratio of photogenerating component to PEC of 0.001-2.0. Applicants submit that this table does not disclose the claimed range with sufficient specificity to anticipate. MPEP § 2131.03(II). The molar ratio of PEC:BCFM, by Applicants' calculations, translates to a weight ratio of 1-99. The disclosed ranges are very broad, covering two orders of magnitude as to the weight ratio of PEC:BCFM and three orders of magnitude as to the weight ratio of photogenerating component to PEC. The claimed ranges (about 45:15 to about 55:18 for PEC:BCFM and about 1:15: to about 1:18 for photogenerating component to PEC) are very narrow in comparison. Applicants submit that this difference shows that Spiewak is not sufficiently specific to anticipate.

For these reasons, Spiewak cannot anticipate.

Spiewak does not render the instant claims obvious.

First, not all claim limitations are met. Spiewak discloses a hole transport polymer. As discussed above, regardless of whether the hole transport polymer is considered the binder, the hole transport component, or both with regards to the instant claims, a claim limitation is not met. As also noted above, Spiewak discusses the use of polymeric binder with hole transport molecules, but does not discuss their weight ratios. In other words, Spiewak provides no teachings regarding the ratio of binder/charge

transport/electron transport component. The lack of these teachings means that one of ordinary skill in the art would not be motivated to make the imaging member of the instant claims.

Applicants also analogize the instant claims as a subgenus of the genus taught by Spiewak. MPEP § 2144.08. Applicants again note the narrowness of the claimed ranges compared to the large genus taught by Spiewak and the fact that none of the Examples fall in (or near) the claimed ranges. Applicants submit that the subgenus cannot be rendered obvious by the teachings of Spiewak.

The Examiner states that it would have been obvious to use the specific ratios of the components disclosed by Spiewak in the table of column 5. However, using any combination of the endpoints of the two ratios would not arrive at an imaging member falling within the instant claims. Applicants submit that to arrive at a member that falls within the claimed ranges, the Examiner must use knowledge disclosed only in Applicants' disclosure, i.e. by hindsight reasoning. Applicants note that the ranges of claims 12 and 13 are even narrower than claim 1, yet the Examiner has made no statements as to why those narrower claims would also be obvious.

For these reasons, the instant claims are not obvious.

For these reasons, Applicants request withdrawal of the 102/103 rejection based on Spiewak.

### **CONCLUSION**

For these reasons, the pending claims (1, 8-15, 17-30, 33-34, and 36-39) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

It is believed that no fee is due in conjunction with this response. If, however, it is determined that fees are due, authorization is hereby given for deduction of those fees, other than the issue fees, from Deposit Account No. 24-0037.

Respectfully submitted,  
FAY SHARPE LLP



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